

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES E. WICKS and YUTAKA HASEGAWA

Appeal No. 2000-2226
Application No. 08/827,107

ON BRIEF

Before HAIRSTON, BARRY, and LEVY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1, 5-8, and 10-18. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse and remand.

BACKGROUND

The appellants' invention concerns wireless telephony. Since their introduction, wireless telephones have become increasingly smaller. A typical wireless telephone features a liquid crystal display for presenting text. According to the appellants, providing an easily read display, however, is at odds with providing a small unit. (Spec. at 3.)

By using a virtual dialer in lieu of a physical, numeric keypad, the appellants assert that their wireless telephone allows more room for an enhanced display without increasing the size of the unit. (Spec. at 3.) The virtual dialer includes a short joystick and an image of a telephone's numeric keypad on a display. The joystick is used to move a cursor around the image. When the cursor highlights the image of the key representing the digit to be dialed, the joystick is pressed. The wireless telephone also includes an antenna movable between an extended and a retracted position. When in the retracted position, the antenna doubles as a belt clip.

A further understanding of the invention can be achieved by reading the following claim:

15. A wireless telephone unit comprising:

an antenna which rotates about a pivotal joint so as to be movable between a first extended position and a second retracted position;

wherein said antenna serves as a clip when in said second retracted position.

Claims 1, 7, 8, 10, 11, and 14 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,436,954 ("Nishiyama") in view of U.S. Patent No. 5,841,849 ("Macor") Claims 5, 6, 12, and 13 stand rejected under § 103(a) as obvious over Nishiyama in view of Macor further in view of U.S. Patent No. 5,551,069

("Harrison"). Claims 15-18 stand rejected under § 103(a) as obvious over Harrison in view of U.S. Patent No. 5,197,091 ("Takagi").

OPINION

After considering the record, we are persuaded that the examiner erred in rejecting claims 1, 5-8, and 10-18. Accordingly, we reverse and remand. Our opinion addresses the following groups of claims:

- claims 1 and 5-7
- claims 8 and 10-14
- claims 15-18.

I. Claims 1 and 5-7

Rather than reiterate the positions of the examiner or appellants *in toto*, we address the main point of contention therebetween. The examiner asserts, "Macor states 'a joystick that is easily manipulated with a figure by user' , as disclosed on column 4, lines 8-9; and a [sic] indented (304) portion [sic] in the top which reads on 'any manipulation member . . . that allow a user to operate the device can be used', as disclosed on column 4, lines 25-31[.]" (Examiner's Answer at 4.) The appellants argue, "Nishiyama and Macor fail to teach or suggest the indented top portion of a joystick as claimed. . . ." (Reply Br. at 5.)

"Analysis begins with a key legal question -- *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). Here, independent claim 1 specifies in pertinent part the following limitations: "a cursor controller comprising a joystick . . . wherein a top portion of said joystick is indented to better accommodate manipulation of said joystick with a human thumb or finger. . . ." Accordingly, the claim requires a joystick having an indented top.

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter is obvious. "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, the examiner does not assert that Nishiyama discloses a joystick at all, let alone a joystick having an indented top. Instead, he relies on "a [sic] indented (304)

portion [sic]," (Examiner's Answer at 4), of Macor's "ergonomic joystick 300. . . ." Col. 4, l. 14. The portion 304, however, is not an indent. To the contrary, it is a "friction bump 304. . . ." *Id.* at l. 16. The examiner fails to allege, let alone show, that the addition of Harrison cures the deficiency of Nishiyama and Macor. Absent a teaching or suggestion of a joystick having an indented top, the examiner fails to present a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejections of claim 1 and of claims 5-7, which fall therewith.

II. Claims 8 and 10-14

The examiner asserts, "Nishiyama discloses a 3X3 array with a zero button at the bottom see figure 1, item 13." (Examiner's Answer at 4-5.) The appellants argue, "the Examiner has still failed to indicate how or where Macor and Nishiyama teach or suggest the . . . two successive downward movements of a joystick being used to reach a zero key as claimed. . . ." (Reply Br. at 6.)

Independent claim 8 specifies in pertinent part the following limitations:
"displaying an image of a numeric keypad on a display, said image comprising a plurality of digit keys with keys for digits 1 to 9 being arranged in a 3 x 3 array; . . . wherein said image also comprises a zero digit key located below said 3 x 3 array, said method comprising moving said joystick downward twice in succession to highlight said

zero digit key." Accordingly, the claim requires displaying an image of a 3x3 array of digit keys and a zero digit underneath the array and moving a joystick downward twice to highlight the zero digit key with a cursor.

As aforementioned, the examiner relies on item 13 of Nishiyama. Although the item may be a 3x3 array of digit keys having a zero digit underneath the array, it is not an image on a display. To the contrary, the item is a "plurality of button keys mounted on said key panel member on the front side of said telephone case," col. 10, ll. 8-9, i.e., a physical, numeric keypad. The examiner fails to allege, let alone show, that the addition of Macor or Harrison cures the deficiency of the primary reference. Absent a teaching or suggestion of displaying an image of a 3x3 array of digit keys and a zero digit underneath the array and moving a joystick downward twice to highlight the zero digit key with a cursor, the examiner fails to present a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejections of claim 8 and of claims 10-14, which fall therewith.

III. Claims 15-18

The examiner asserts, "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Harrison by specifically providing an antenna which rotates about an [sic] pivotal joint so as to be movable between a first

extended position and a second retracted position, as disclosed by Takagi. (Final Rejection at 7-8.) He adds, “[t]he motivation for modification would have been to sufficiently reduce the size of the main body of the portable telephone. . . .” (*Id.* at 8.) The appellants argue, “making the antenna/clip (7) taught by Harrison rotatable would obviously have no effect on the size of the ‘main body’ of the telephone.” (Reply Br. at 2.)

“[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). “Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicants.” *Id.*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

Here, Harrison discloses “a radio telephone ha[ving] an antenna [7] which, rather than extending away from the housing of the apparatus, is bent around the housing to overlap it in a clip-like formation.” Abs., ll. 1-4. Contrary to the examiner’s assertion,

making the clip-like antenna 7 rotatable about a pivotal joint so as to be movable between extended and retracted positions, would not reduce the size of “[t]he main housing 3,” col. 2, ll. 16-17, of the radio telephone. Because Harrison’s “invention [already] has the advantage of providing a compact antenna,” co. 1, ll. 52-53, such a modification would do little to reduce the size of the antenna. Therefore, we reverse the obviousness rejection of claim 15 and of claims 16-18, which fall therewith.

Our reversal of the examiner’s rejection of claims 15-18 is based only on his proposal to modify Harrison’s clip-like antenna to be movable as in Takagi for the aforementioned reason. Nevertheless, we notice Harrison’s disclosure that “[i]n EP-A-0036442 there is disclosed a personal radio transceiver in which a pivoted antenna is movable between an extended operating position and a retracted non-operating position, and, which, in the non-operating position, doubles as a pocket clip.” Col. 1, ll. 27-31. Furthermore, although the examiner fails to show the desirability of modifying Harrison’s clip-like antenna to be movable like Takagi’s, that does not mean that it would not have been obvious to apply Takagi’s teaching of a movable antenna as a primary reference and to modify it with a teaching of using an antenna as a belt clip, e.g., Harrison’s teaching of an “antenna ha[ving] the additional function of a belt or pocket clip.” *Id.* at ll. 57-58.

Although the disclosure of EP-A-0036442 appears relevant to the invention of claim 15, and modifying Takagi's teaching of a movable antenna to operate as a belt-clip also may have been obvious, "the Board is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). "The review authorized by 35 U.S.C. Section 134 is not a process whereby the . . . [B]oard . . . examine[s] the application and resolve patentability in the first instance." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999). Therefore, we remand the instant application to the examiner to consider the relevance of EP-A-0036442 and of Takagi in view of Harrison. The examiner should reassess the patentability of each of claims 15-18 in view of EP-A-0036442 and of Takagi in view of Harrison. He should document his conclusions on the record, e.g., by making a rejection or by writing reasons for allowance. "An examiner's answer must not include a new grounds of rejection. . . ." 37 C.F.R. § 1.193(a)(2)(2001). Accordingly, if the examiner decides that any claim is unpatentable, he should reopen prosecution to make an appropriate rejection in a new Office action and give the appellants an opportunity to respond thereto. M.P.E.P. § 1208.01 (8th ed., Aug. 2001).

CONCLUSION

In summary, the examiner's rejections of claims 1, 5-8, and 10-18 under § 103(a) are reversed. Furthermore, the instant application is remanded to the examiner to consider the relevance of EP-A-0036442 and of Takagi in view of Harrison and to act accordingly. Because it is being remanded for further action, the application is a "special" application. *Id.* at § 708.01(D). As such, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting the status of the appeal (e.g., abandonment, issue, reopening prosecution).

REVERSED AND REMANDED

KENNETH W. HAIRSTON
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

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Appeal No. 2000-2226
Application No. 08/827,107

Page 12

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